

REMARKS

Claims 1-42 are pending in the application, claims 32–42 being newly added. Applicant respectfully requests reconsideration of all pending claims in view of the following Remarks.

Claims 1-2, 4, 7-10, 13, 16-24, and 26-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,760,773 to *Berman et al.* (“*Berman*”) in view of U.S. Patent No. 6,191,777 to *Yasuhara et al.* (“*Yasuhara*”). Office Action, Item 2, at page 2. Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berman* in view of *Yasuhara*. Office Action, Item 6, at page 5.

Applicant respectfully traverses the rejections under this section because the combination of *Berman* and *Yasuhara* is improper.

I. The Office Action Fails to Articulate Any Suggestion or Motivation to Combine References

To establish a *prima facie* case of obviousness, there must be at least a suggestion or motivation to combine references. MPEP 2143. The motivation to combine references can be based on the nature of the problem to be solved, the teaching of the prior art itself, or the knowledge of a person of skilled in the art. MPEP 2143.01. But, importantly, the burden of establishing *prima facie* obviousness is not met “without some objective reason to combine the teachings of the references.” *Id.* (citing *Ex Parete Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

The Office Action asserts that *Berman* discloses all features of at least independent claims 1, 10, 19, 22, and 26, except for the feature of “interactive tools associated with a drawing activity,” and variations thereof, recited in the claims. Office Action, Item 3, at page 4. Next, the Office Action asserts that *Yasuhara* discloses “interactive tools associated with a drawing activity.” *Id.* The Office Action then provides the following analysis:

“By having interactive tools associated with a drawing activity, one of ordinary skill in the art would provide a portable graphic computer apparatus suitably used by children to draw a picture. Therefore, it would have been obvious to one of ordinary skill in

the art at the time of the invention was made to modify *Berman* to further include interactive tools associated with and displaying indicia of drawing activities as taught by *Yasuhara*. To do so would provide a portable graphic computer apparatus suitably used by children to draw a picture.”

Applicant understands the second sentence (beginning with “[t]herefore”) to be a conclusion. Thus, as best Applicant can determine, the only stated rationale for combining *Berman* and *Yasuhara* is to provide a “portable apparatus suitably used by children to draw a picture.” But this “benefit” is provided by *Yasuhara* alone. See column 4 lines 44-47; abstract (additional support of portability); column 9, lines 55-56 (additional support for use by children to draw a picture) of *Yasuhara*. It is axiomatic that where a single reference is all that is required to achieve the benefit, there is no motivation or suggestion to combine references. Thus, the Office action fails to provide an object reason to combine the references. Applicant respectfully submits that the conclusion of obviousness expressed in the Office Action could only have been reached using impermissible hindsight reasoning. Independent claims 1, 10, 19, 22, 26, and 31 are allowable for at least this reason.

II. The Combination of References is Improper for at Least Two Reasons

There can be no motivation to combine references, and thus no *prima facie* case of obviousness, where doing so would change the principle of operation of a reference, or where the references otherwise teach away from such a combination. MPEP 2143.01.

A. The Combination Changes the Principle of Operation of a Reference

Applicant respectfully submits that the principle of operation of interactive tools in *Berman* and *Yasuhara* are fundamentally different. *Berman* discloses action handles (e.g., 40a and 40b) on a graphic display 18. See Fig. 2 of *Berman*. By contrast, *Yasuhara* discloses that menu selection area 10c is on a computer 1. See Fig. 1 of *Yasuhara*. Significantly, computer 1 is separate and apart from monitor 2 and picture screen 2a. *Id.* Unlike the apparatus disclosed in *Berman*, the principle of operation of the *Yasuhara* device is that all user input is made via

computer 1, and no user inputs are made on picture screen 2a. *Id.* Thus, a combination of *Yasuhara* and *Berman* requires a change to the principle of operation of the *Yashuhara* reference with respect to the drawing activity recited in independent claims 1, 10, 19, 22, 26, and 31. Claims 1, 10, 19, 22, 26, and 31 are allowable for at least this reason.

In another respect, the principle of operation of *Berman* and *Yasuhara* are fundamentally different with respect to use of a stylus. For instance, in *Berman*, a pen or stylus 12 interfaces with a display 18. See Fig. 1 and column 7, lines 53 – 57 of *Berman*. By contrast, in *Yasuhara*, a pen 11 interfaces with tablet 10 (not with picture screen 2a). See Fig. 2 and column 5, lines 45-50 of *Yasuhara*. Thus, a combination of *Yasuhara* and *Berman* requires a change to the principle of operation of the *Yashuhara* reference with respect to the stylus interaction recited in dependent claims 8, 9, 17, and 18. Claims 8, 9, 17, and 18 are allowable for at least this reason.

B. The References Themselves Teach Away From Such Combination

As best Applicant can determine, in combining references, the Office Action suggests that the menu area 10c could be combined with a picture screen or other display to enable a drawing activity. *Yasuhara* explicitly teaches away from such a modification, however. For example, *Yasuhara* teaches that having separation between the computer 1 and the monitor 2 is advantageous for independent miniaturization of the computer 1. See column 12, lines 12-15 of *Yasuhara*. *Yasuhara* also teaches that the disclosed configuration of the computer 1 simplifies the mechanical portion of the disclosed portable graphic computer apparatus. See column 12, lines 18-23 of *Yasuhara*. Moreover, *Yasuhara* illustrates that, for drawing activity, making inputs on a separate computer 1 allows for the use of a drawing template 52 without obscuring the monitor 2. See Figs 8-9 of *Yasuhara*. For at least these three separate reasons disclosed in *Yasuhara*, it is improper to combine *Yasuhara* and *Berman* for the “drawing activity,” and combinations thereof, recited in independent claims 1, 10, 19, 22, 26, and 31. Claims 1, 10, 19, 22, 26, and 31 are allowable for at least this reason.

III. All Pending Claim are Allowable

Claims 3, 5-6, 11-12, 14-15, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berman* in view of *Yasuhara*, and further in view of U.S. Pub. No. 2002/0135615 by Lang (“*Lang*”). Office Action, Item 4, at page 4. But the addition of *Lang* cannot cure the improper combination of *Berman* and *Yasuhara* discussed in sections I. and II. above.

Independent claims 1, 10, 19, 22, 26, and 31 are allowable for at least the reasons provided in sections I. and II. above. Claims 2-9, 29, and 30 are allowable for at least the reason that they depend from allowable claim 1. Claims 11-18 are allowable for at least the reason that they depend from allowable claim 10. Claims 20 and 21 are allowable for at least the reason that they depend from allowable claim 19. Claims 23-25 are allowable for at least the reason that they depend from allowable claim 22. Claims 27 and 28 are allowable for at least the reason that they depend from allowable claim 26. Withdrawal of the rejection to claims 1-31 under 35 U.S.C. § 103(a) is respectfully requested.

Applicant believes that newly-added claims 32-42 are also in condition for allowance.

IV. Applicant Demands that the Examiner Produce Additional Authority

If the Examiner maintains the rejection of claims 1-31 based on a combination of *Berman* and *Yasuhara*, and if Examiner’s rationale for such combination is outside of the cited references, Applicant demands that the Examiner produce evidence supporting the combination of *Berman* and *Yasuhara*, especially in view of: a) the change in principle of operation, and b) the extent of teaching away from such combination contained in the references themselves (as discussed above).

CONCLUSION

All of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

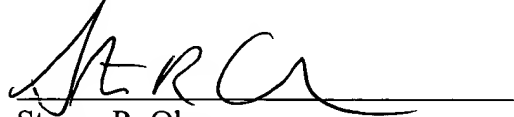
Prompt and favorable consideration of this Amendment is respectfully requested.

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